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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,214	01/28/2004	Ray Bojarski	00167-524001 / 02-31-0483	7657

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Joel R. Petrow, Esq.
Chief Patent Counsel
Smith & Nephew, Inc.
1450 Brooks Road
Memphis, TN 38116

EXAMINER	
WOO, JULIAN W	

ART UNIT	PAPER NUMBER
3773	

MAIL DATE	DELIVERY MODE
10/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/765,214	BOJARSKI ET AL.	
	Examiner	Art Unit	
	Julian W. Woo	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6-10,12,13 and 15-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6-10,12,13 and 15-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/8/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 6, 8-10, 12, 15-17, 19, 22-26, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson et al. (6,430,804). Nelson et al. disclose, at least in figures 1 and 4-7, a device (60) including a first portion (64) defining a tapered hole (78) configured for guiding a member into a tube that can be coupled to the body, a guide means, or a first terminal end portion; a second portion (62) defining a bore, a receiving means, or a second terminal end portion; a projecting surface (74 and/or 68) formed on an internal surface of the body at an intersection between the tapered hole and the bore, the body defining a slot (72) communicating with the hole and the bore or a separating means, where the bore has a constant diameter, where the slot extends from the tapered hole and the bore to an external surface of the body, where the device includes a handle (66, 50, or 92) extending from the body, where the body is configured for connection to an end of the tube (82), where the tube (82) defines an opening for receiving the member, where the width of the tube opening is substantially the same as the width of the narrowest portion of the tapered hole (at 76), where the slot (72) extends from a terminal end of the first portion to a terminal end of the second portion or from the first terminal end portion to the second terminal end

portion, and where the device includes a cylindrical handle (50 or 92) connected to the body and projecting on only one side opposite to the slot.

3. Claims 1, 7, 9, 18, 20, 21, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mericle et al. (5,423,837). Mericle et al. disclose, at least in figures 2, 4 and 5 and in col. 3, line 15 to col. 4, line 57; a device including a first portion (6) defining a tapered hole (24) configured for guiding a member into a tube (26) that can be coupled to the body, a second portion (14 or 4) defining a bore, a projecting surface (proximal of 30, where the surface radially projects inwardly and outwardly relative to the bore or element 14 between elements 6 and 4) formed on an internal surface of the body at an intersection between the tapered hole and the bore, the body defining a slot (30) communicating with the hole and the bore, and a tube (26); where the device includes a member that comprises a suture thread ("suture material"). Mericle et al. also disclose, at least in figure 2 and in col. 3, lines 22-53 and col. 4, lines 45-57; a method including coupling a body (6) to an end of a tube (26), the body defining a tapered hole and a slot (30); guiding a member ("suture material") into the tube (for cutting of the suture material at the distal tip of 26, where shearing of the suture material or cutting of the suture material against the anvil-like, inner distal end surface of element 6 inherently results in a portion of suture material within the "circular cutting edge" of element 26) through the tapered hole; and separating the body and the member by passing the member through the slot, where coupling includes receiving the end of the tube in a bore in the body (at the proximal portion of 6 and distal of 14), the bore communicating

with the tapered hole, and where the body is decoupled from the end of the tube (when the tube is retracted by spring 18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. (6,430,804) in view of Stivers (2,882,645). Nelson et al. disclose the invention substantially as claimed, but do not disclose that the bore is tapered. Stivers teaches, at least in figure 2 and in col. 2, lines 1-5, a device including a body having first and second portions, where the bore of the second portion (11) includes a tapered bore. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Stivers, to modify the bore of the device of Nelson et al., so that it is tapered. Such a modification would allow the device of Nelson et al. to not

only contain the tail of a balloon, the tapered bore would allow securement of the tail to a reed.

Response to Amendment

6. Applicant's arguments with respect to claims 1, 3, 4, 6, 8-10, 12, 13, 15-17, 19, 22-26, and 29-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the rejection based on Mericle have been considered but are not persuasive. That is, as shown in the rejection above, Mericle indeed discloses a projecting surface (the surface proximal of 30 or the surfaces of element 14 between elements 6 and 4) as claimed; while the method of Mericle includes guiding a member (suture material in this case) into a tube (e.g., contained within the circular or tubular cutting edge upon severing of the suture material against the inner, distal endwall of element 6).

The rejections of claims under 35 U.S.C. 112 are hereby withdrawn.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Julian W. Woo/
Primary Examiner, Art Unit 3773

October 18, 2008